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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LEROUX, ETIENNE PIERRE	
ART UNIT	**PAPER NUMBER**
2171	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/887,739	SINGER ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-27 and 39-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-27 and 39-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-27 and 39-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a system which compares the words with a dictionary to identify words which do not appear in the dictionary." The metes and bounds of instant invention are difficult to determine because the claimed dictionary is unclear. Examiner maintains that if a French or German language dictionary were consulted, very few of the words appearing in an English language website would appear in the French or German dictionary. Obviously a French or German language dictionary is not per the intent of the present invention which seeks to determine candidates for hot-links. Furthermore, examiner found a dictionary of trademarks which would be of interest to the trademark side of the PTO. Consulting a trademark dictionary would exclude all trademarks and there would be no trademark candidates for hot-links. Obviously a trademark dictionary is not per the intent of the present invention. Finally, to conclude this rather less than rigorous analysis, examiner points out that as of 3/26/2004, the West search engine provided by the PTO produced 38,317 hits on the word dictionary. Examiner is unable to ascertain which, if any, of the above dictionaries are pertinent to applicant's invention.

Independent claims 22, 39 and 52 include language similar to above language pertinent to claim 1.

Claims 15-21, 23-38, 40-51 and 53-56 are rejected for being dependent from rejected base claim 1.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,794,257 issued to Liu et al (hereafter Liu '257)

Regarding claim 14, Liu '257 discloses:

a parser which separates text into words and phrases [Fig 3, 32 and col 3, lines 26-35]

a system which compares the words and phrases with entries for which a web site is available and generates an output indicating one or more web sites associated with one of the words and phrases [Fig 3, 36]

a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one or more of the web sites should be associated with the word and phrase [Fig 3, 37 and col 3, lines 41-42]

an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input [Figs 3, 38 and 39]

Regarding claim 15, Liu '257 discloses a web search engine [Fig 3, 38]

3. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,122,647 issued to Horowitz et al (hereafter Horowitz '647):

Regarding claim 14, Horowitz '647 discloses:

a parser which separates text into words and phrases [col 8, lines 62 through col 9, line 9 and Fig 6, 120 and col 8, lines 1-5]

a system which compares the words and phrases with entries for which a web site is available and generates an output indicating one or more web site associated with one of the words and phrases [Fig 7, 716]

a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one or more of the web sites should be associated with the word and phrase [col 11, lines 16-24]

an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input [Fig 8, 810] .

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14, 15, 22, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0026507 issued to Sears et al (hereafter Sears '507) in view of Liu '257

Regarding claims 14, 22 and 39, Sears '507 discloses:

a parser which separates text into words and phrases [paragraph 0111]

a system which compares the words and phrases with entries for which a web site is available and generates an output indicating one or more web site associated with one of the words and phrases [paragraph 0099]

Regarding claims 14, 22 and 39, Sears '507 discloses the essential elements the claimed invention as noted above except for:

1) a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one of the web sites should be associated with the word and phrase

2) an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input.

Liu'257 discloses a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one of the web sites should be associated with the word and phrase [Fig 1]

2) an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input [Fig 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sears '507 to include a system which receives a user input indicating whether a web site should be associated with a word or phrase

and which one of the web sites should be associated with the word and phrase and an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input as taught by Liu '257 for the purpose of linking a new web site to existing web sites containing related information.

Regarding claims 15 and 40, Sears '507 discloses a search engine [paragraph 0109]

6. Claims 16, 23 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507 and Liu '257 as applied to claims 14 and 39 above, and further in view of Pub No US 2002/0078201 (hereafter Gvily '201).

Regarding claims 16, 23 and 41, the combination of Sears '507 and Liu '257 disclose the essential elements of the claimed invention as noted above except for a dictionary. Gvily '257 discloses a dictionary [claim 14]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sears '507 and Liu '257 to include a dictionary as taught by Gvily '257 for the purpose of locating recognized words [claim 14].

Claims 17 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507, Liu '257 and Gvily '201 as applied to claims 16 and 39 above, and further in view of US Pat No 4,958,285 issued to Tominaga (hereafter Tominaga '285).

Regarding claims 17 and 42, the combination of Sears '507, Liu '257 and Gvily '201 disclose the essential elements of the claimed invention as noted above except for a dictionary augmented by rules. Tominaga '285 discloses a dictionary augmented by rules. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sears '507, Liu '257 and Gvily '201 to include a dictionary augmented by rules as taught by Tominaga '285 for the purpose of efficient translation [col 1, lines 10-23].

7. Claims 18, 26, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507 and Liu '257 as applied to claims 14, 22 and 39 above, and further in view of Pub No US 2002/0174132 (hereafter Silverman '132).

Regarding claims 18, 26, 43 and 44, the combination of Sears '507 and Liu '257 disclose the essential elements of the claimed invention as noted above except for searching for a trademark. Silverman '132 discloses a trademark [abstract]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sears '507 and Liu '257 to include searching for a trademark as taught by Silverman '132 for the purpose of detecting illegal use of a trademark [abstract].

Claims 19, 27, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507 and Liu '257 as applied to claims 14, 22 and 39 above, and further in view of Pub No US 2002/0194018 (hereafter Scott '018).

Regarding claims 19, 27, 45 and 46, the combination of Sears '507 and Liu '257 disclose the essential elements of the claimed invention as noted above except for searching for a corporate name. Scott '018 discloses searching for a corporate name [paragraph 0010]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the combination of Sears '507 and Liu '257 to include searching for a corporate name as taught by Scott '018 for the purpose of matching business interests [abstract].

Claims 20, 24, 25, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507 and Liu '257 as applied to claims 14, 22 and 39 above, and further in view of US Pat No 6,594,654 issued to Salam et al (hereafter Salam '654).

Regarding claims 20, 24, 25, 47 and 48, the combination of Sears '507 and Liu '257 disclose the essential elements of the claimed invention as noted above except for searching for capitalization. Salam '654 discloses searching for capitalization [col 19, lines 38-50]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sears '507 and Liu '257 to include searching for capitalization as taught by Salam '654 for the purpose of reducing errors in search requests [col 19, line 49].

Claims 21 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sears '507, Liu '257 and Salam '654 as applied to claims 20 and 47 above, and further in view of Pub No US 2002/0198909 issued to Huynh et al (hereafter Huynh '909).

Regarding claims 21 and 49, the combination of Sears '507, Liu '257 and Salam '654 disclose the essential elements of the claimed invention as noted above except for recognizing capitalization within a word. Huynh '909 recognizes capitalization within a word [paragraph 0179]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sears '507, Liu '257 and Salam '654 to include

recognizing capitalization within a word as taught by Huynh '909 for the purpose of allowing IT departments to include recognizers [paragraph 0179].

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,982,370 issued to Kamper (hereafter Kamper '370) in view of Liu '257

Regarding claim 22 Kamper '370 discloses:

a program component which identifies a portion of the text for which a web site may exist [Fig 4b and col 6, lines 9-32]

a program component which seeks to locate one or more web sites for the identified portions of text [col 6, lines 33-49]

a program component which displays the one or more located web sites which are associated with a identified portion of the text [Fig 5d]

Regarding claim 22, Kamper '370 discloses the essential elements of the claimed invention as noted above except for a program component which responds to a user input to select whether to include a web site and if, more than one web site is identified, to select which web site or web sites will be included and a program component which creates a web site based on the text and includes a hot link to the one or more web sites which were selected by the user. Liu '257 discloses a program component which responds to a user input to select whether to include a web site and if, more than one web site is identified, to select which web site or web sites will be included [col 3, lines 38-41] and a program component which creates a web site based on the text and includes a hot link to the one or more web sites which were selected by the user [col 3, lines 42-46]. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Kamper '370 to include a program component which responds to a user input to select whether to include a web site and if, more than one web site is identified, to select which web site or web sites will be included and a program component which creates a web site based on the text and includes a hot link to the one or more web sites which were selected by the user as taught by Liu '257 for the purpose of creating hyperlinked multimedia manuals which can provide efficient information access [col 1, lines 56-59]

Response to Arguments

Applicant's arguments filed 1/26/2004 have been fully considered but they are not persuasive.

Applicant Argues:

Applicant states the following in the third paragraph on page 11:

"The present invention, as described in the specification and illustrated in the accompanying drawings, is a novel method and system for creating a web page or the code for creating a web page with hotlinks from text using various tools to determine what hotlinks to include. These tools are claimed in various combinations and include a dictionary for determining common words which can be excluded from consideration, a list of past links which have been used (a past links list), a list of words for which no links can be determined (a no-links list), and a user input to select a link. None of the references, alone or in combination, includes these features for a web page generation system or method or makes them obvious. The art does show some of the features of the present invention, but does not suggest their combination. In fact, some of the

features shown in the cited prior art (like the dictionary in the Gvily publication) are not shown for the purpose which it is used in the present invention."

Examiner Responds:

Amended Claim 1 recites "a system which compares the words with a dictionary to identify words which do not appear in the dictionary." It is difficult to determine which words applicant is claiming because applicant does not qualify the term 'dictionary.' Examiner maintains that if a French or German language dictionary were consulted, very few of the words appearing in an English language website would appear in the French or German dictionary and thus a plurality of non-English words would be potential candidates for hot-links. Obviously a French or German language dictionary is not per the intent of the present invention. Furthermore, examiner found a dictionary of trademarks which would be of interest to the trademark side of the PTO. Obviously, all trademarks would appear in this dictionary and once again such a dictionary is not per the intent of the present invention because there would be no hot-link candidates because all trademarks would be included in the trademark dictionary. Finally, to conclude this rather less than rigorous analysis, examiner points out that as of 3/26/2004, the West search engine provided by the PTO produced 38,317 hits on the word dictionary. Examiner is unable to ascertain which, if any, of the above dictionaries are pertinent to applicant's invention.

Furthermore, in response to applicant's argument that "features shown in the cited prior art (like the dictionary in the Gvily publication) are not shown for the purpose which it is used in the present invention" is merely a recitation of the intended use of the claimed dictionary. In a claim drawn to structure, such a claim 14, the invention must result in a structural difference

between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

3/29/2004

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